

ORIGINAL

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

USDC SDNY
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APOLLO HEALTHCARE CORP. d/b/a
APOLLO HEALTH AND BEAUTY CARE,

Plaintiff,

v.

SOL DE JANEIRO USA INC. and
SOL DE JANEIRO IP, INC.,

Defendants.

Civil Action No. 1:22-cv-07719-LLS

SOL DE JANEIRO USA INC. and
SOL DE JANEIRO IP, INC.,

Counterclaim-Plaintiffs,

v.

APOLLO HEALTHCARE CORP. d/b/a
APOLLO HEALTH AND BEAUTY CARE
and COSTCO WHOLESALE CORP.,

Counterclaim-Defendants.

SCHEDULING ORDER

The parties respectfully submit this Proposed Scheduling Order pursuant to the Court's November 4, 2022 Order for Conference Pursuant to Rule 16(b) and the Court's November 16, 2022 Order Granting Letter Motion to Adjourn Conference. ECF Nos. 32 and 37.

1. the date of the conference and the appearances for the parties;

A Rule 16(b) Conference was held on Wednesday, January 18, 2023 at 12:00 noon in courtroom 21C before the Honorable Judge Louis L. Stanton. Craig Krummen, Esq., of the law firm Greenberg Traurig appeared on behalf of Plaintiff/Counterclaim-Defendant Apollo Healthcare Corp. and Counterclaim-Defendant Costco Wholesale Corp. John Margiotta, Esq., and

Brian Leary, Esq., of the law firm Fross Zelnick appeared on behalf of Defendants/Counterclaim-Plaintiffs Sol De Janeiro USA Inc. and Sol De Janeiro IP, Inc.

2. a concise statement of the issues as they then appeared;

This is a complex intellectual property matter involving alleged trade dress infringement and alleged unfair competition. Plaintiff/Counterclaim-Defendant Apollo Healthcare Corp. (“Apollo”) commenced this action by filing a Complaint and asserting a claim for declaratory judgment that the packaging for its NUTRIUS® BRAZILIAN BODY BUTTER CREAM product does not infringe any purported trade dress rights owned by Defendants/Counterclaim-Plaintiffs Sol De Janeiro USA Inc. and Sol De Janeiro IP, Inc. (“SDJ”) relating to the product packaging used in conjunction with their BRAZILIAN BUM BUM CREAM product. Plaintiff Apollo also asserted declaratory judgment claims concerning the unenforceability of Defendants SDJ’s trade dress.

Defendants/Counterclaim-Plaintiffs SDJ, in turn, filed a Counterclaim and asserted trade dress infringement and unfair competition claims against Plaintiff/Counterclaim-Defendant Apollo and Counterclaim-Defendant Costco Wholesale Corp. (“Costco”). In addition, Defendants/Counterclaim-Plaintiffs SDJ asserted a contributory infringement claim against Plaintiff/Counterclaim-Defendant Apollo.

Issues Presented In Plaintiff Apollo’s Amended Complaint:

a. Whether Defendants/Counterclaim Plaintiffs SDJ’s alleged trade dress rights for the product packaging used in conjunction with their BRAZILIAN BUM BUM CREAM product lack the requisite requirements to be protectable on the Principal Register and to be enforceable.

b. Whether Defendants/Counterclaim Plaintiffs SDJ's purported trade dress for their product packaging is not protectable or enforceable because it fails to function as a source identifier.

c. Whether Defendants/Counterclaim Plaintiffs SDJ's purported trade dress for their product packaging is not protectable or enforceable because the product packaging features are information, ornamental, and/or decorative.

d. Whether Defendants/Counterclaim Plaintiffs SDJ's purported trade dress for their product packaging is not protectable or enforceable because the product packaging features are functional.

e. Whether Defendants/Counterclaim Plaintiffs SDJ's purported trade dress for their product packaging is not protectable or enforceable because the product packaging features are non-distinctive.

f. Whether Plaintiff/Counterclaim Defendant Apollo's NUTRIUS® BRAZILIAN BODY BUTTER CREAM has infringed any valid, distinctive and enforceable trade dress rights owned by Defendants relating to the sale of product packaging used in conjunction with their BRAZILIAN BUM BUM CREAM product, either directly or by inducing others to infringe or by contributing to infringement by others.

g. Whether Plaintiff/Counterclaim Defendant Apollo is entitled to recover damages.

h. Whether this is an exceptional cause under 15 U.S.C. § 1117.

i. Whether Plaintiff/Counterclaim Defendant Apollo is entitled to recover exemplary and punitive damages.

j. Whether Plaintiff/Counterclaim Defendant Apollo is entitled to recover its attorney's fees, costs, and expenses in connection with this action.

k. Whether Plaintiff/Counterclaim Defendant Apollo is entitled to recover interest, including prejudgment interest.

Issues Presented In Defendants' Counterclaims:

a. Whether Plaintiff/Counterclaim Defendant Apollo has infringed trade dress rights owned by Defendants relating to the sale of product packaging used in conjunction with their BRAZILIAN BUM BUM CREAM product, either directly or by inducing others to infringe or by contributing to infringement by others.

b. Whether Plaintiff/Counterclaim Defendant Apollo's actions constitute willful trade dress infringement in violation of 15 U.S.C. § 1125(a).

c. Whether Plaintiff/Counterclaim Defendant Apollo's actions constitute unfair competition in violation of 15 U.S.C. § 1125(a) and/or New York common law.

d. Whether Counterclaim Defendant Costco has infringed trade dress rights owned by Defendants relating to the sale of product packaging used in conjunction with their BRAZILIAN BUM BUM CREAM product.

e. Whether Counterclaim Defendant Costco's actions constitute willful trade dress infringement in violation of 15 U.S.C. § 1125(a).

f. Whether Counterclaim Defendant Costco's actions constitute unfair competition in violation of 15 U.S.C. § 1125(a) and/or New York common law.

g. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to injunctive relief.

h. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to an accounting.

i. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to recover damages.

j. Whether this is an exceptional cause under 15 U.S.C. § 1117.

k. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to recover exemplary and punitive damages.

l. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to recover their attorney's fees, costs, and expenses in connection with this action.

m. Whether Defendants/Counterclaim-Plaintiffs SDJ are entitled to recover interest, including prejudgment interest.

3. a schedule including:

A summary of proposed deadlines for this Proposed Scheduling Order is attached as Exhibit I.

a. the names of persons to be deposed and a schedule of planned depositions;

The parties shall complete their Rule 30(b)(6) depositions and fact witness depositions on or before September 15, 2023. The parties shall complete expert witness depositions on or before January 12, 2024. Discovery began very recently, and the parties have not yet determined the names of the persons to be deposed.

b. a schedule for the production of documents;

The parties shall serve their Initial Disclosures on or before January 31, 2023. The parties shall serve their First Set of Document Requests on or before February 15, 2023.

c. dates by which (i) each expert's reports will be supplied to the adversary side, and (ii) each expert's deposition will be completed;

Expert reports and disclosures for the party with the burden of proof on the particular issue shall be served on or before October 16, 2023. Rebuttal expert reports and disclosures shall be

served on or before November 15, 2023. Depositions of expert witnesses shall be completed on or before January 12, 2024.

d. time when discovery is to be completed;

Fact discovery shall be completed on or before September 15, 2023. Expert discovery shall be completed on or before January 12, 2024.

e. the date by which plaintiff will supply his pre-trial order materials to defendant;

Plaintiff and Counter-Plaintiff shall supply their pre-trial materials to their respective opposing parties on or before February 12, 2024.

f. the date by which the parties will submit a pre-trial order in a form conforming with the Court's instructions together with trial briefs and either (i) proposed findings of fact and conclusions of law for a non-jury trial, or (ii) proposed voir dire questions and proposed jury instructions, for a jury trial; and

Plaintiff and Counter-Plaintiff shall submit a pre-trial order in a form conforming with the Court's instructions together with the pre-trial materials described above on or before March 4, 2024.

g. a space for the date for a final pre-trial conference pursuant to Fed. R. Civ. P. 16(e), to be filled in by the Court at the conference.

The final pre-trial conference shall be held on Friday March 8, 2024. at 12 noon

4. a statement of any limitations to be placed on discovery, including any protective or confidentiality orders; LLS

The parties shall follow the limitations placed on discovery as set forth in the Federal Rules of Civil Procedure. The parties shall work in good faith to prepare and file a proposed Stipulation and Protective Order with the Court on or before January 31, 2023.

5. a statement of those discovery issues, if any, on which counsel, after a good faith effort, were unable to reach an agreement;

The parties do not have any discovery issues that they were unable to reach an agreement at this time.

6. anticipated fields of expert testimony, if any;

Discovery very recently began, and the parties have not yet identified all of the anticipated fields of expert testimony. The parties may call liability experts in different fields including, but not limited to, the field of consumer surveys. The parties may also call damages experts.

7. anticipated length of trial and whether to court or jury;

This is a complex case amongst four parties involving trade dress infringement claims, declaratory judgment claims, injunctive relief claims, and damages claims. The parties anticipate that the length of the trial will last at least two weeks.

The Scheduling Order may be altered or amended only on a showing of good cause not foreseeable at the time of the conference or when justice so requires.

Dated: January 11, 2023

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Dated: January 11, 2023

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IT IS SO ORDERED.

Dated: January 18, 2023

By: /s/ Louis L. Stanton
Honorable Judge Stanton
United States District Court
Southern District of New York

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EXHIBIT 1**Summary of Proposed Deadlines**

Deadline for serving Initial Disclosures	January 31, 2023
Deadline for serving First Set of Discovery	February 15, 2023
Deadline to Amend the Pleadings or Join Additional Parties	August 17, 2023
Deadline for Completion of Fact Discovery	September 15, 2023
Deadline for Expert Reports and Disclosure of Expert Testimony for Party With Burden of Proof	October 16, 2023
Deadline for Rebuttal Expert Reports and Disclosure of Rebuttal Expert Testimony	November 15, 2023
Deadline for Completion of Expert Discovery	January 12, 2024
Deadline for Filing Summary Judgment Motions [and Motions to Exclude Experts]	February 14, 2024
Deadline for compliance with Section 4.A.1 of Individual Practices of Judge Lous L. Stanton	21 days after the Court decides the summary judgment motions and motions to exclude experts 2/12/24
Deadline for compliance with Section 4.A.2 of Individual Practices of Judge Lous L. Stanton	42 days after the Court decides the summary judgment motions and motions to exclude experts 2/14/24
Deadline for compliance with Section 4.A.3 of Individual Practices of Judge Lous L. Stanton	63 days after the Court decides the summary judgment motions and motions to exclude experts
Deadline for compliance with Section 4.A.4 and 4.A.5 of Individual Practices of Judge Lous L. Stanton	84 days after the Court decides the summary judgment motions and motions to exclude experts 3/4/24
Date for Rule 16(e) Final Pre-Trial Conference	To be determined by the Court Friday March 8 '24 at
Trial Ready Date	To be determined by the Court 12 noon